

#21



Docket No. 7791-0068-25

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

MARK APPLICATION OF :

PHILLIP WHITE

: EXAMINER: LASTRA, D.

SERIAL NO: 09/317,110 :

CPA FILED: APRIL 4, 2001

: GROUP ART UNIT: 2162

FOR: PROCESS, SYSTEM AND :
COMPUTER READABLE MEDIUM
FOR IN-STORE PRINTING OF...

:

37 CFR 1.192 APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS

WASHINGTON, D.C. 20231

SIR:

RECEIVED
OCT - 9 2001
Technology Center 2100

10/05/2001 CHGUYEN 00000073 09317110

02 FC:120

320.00 OP

Table of Contents

I.	37 CFR 1.192(a)	1
II.	37 CFR 1.192(b)	1
III.	37 CFR 1.192(c)	1
A.	37 CFR 1.192(c)(1) Real Party in Interest	1
B.	37 CFR 1.192(c)(2) Related Appeals and Interferences	1
C.	37 CFR 1.192(c)(3) Status of Claims	1
D.	37 CFR 1.192(c)(4) Status of Amendments	1
E.	37 CFR 1.192(c)(5) Summary of the Invention	2
F.	37 CFR 1.192(c)(6) Issues	6
G.	37 CFR 1.192(c)(7) Grouping of Claims	6
H.	37 CFR 1.192(c)(8) Argument	7
1.	37 CFR 1.192(c)(8)(i)	7
2.	37 CFR 1.192(c)(8)(ii)	7
3.	37 CFR 1.192(c)(8)(iii)	7
4.	37 CFR 1.192(c)(8)(iv)	7
a.	Group 1 - Claims 1, 9, 17, and 25	11
b.	Group 2 - Claims 2, 10, 18, and 26	12
c.	Group 3 - Claims 3, 11, 19, and 27	13
d.	Group 4 - Claims 4, 12, 20, and 28	14
e.	Group 5 - Claims 5, 13, 21 and 29	15
f.	Group 6 - Claims 6, 14, 22 and 30	16
g.	Group 7 - Claims 7, 15, 23 and 31	17

h.	Group 8 - Claims 8, 16, 24 and 32	17
5.	37 CFR 1.192(c)(8)(v)	18
I.	37 CFR 1.192(c)(9) Appendix	18
IV.	37 CFR 1.192(d)	18
V.	Additional Appendices.....	19

I. 37 CFR 1.192(a)

This brief is being filed in triplicate, is accompanied by the fee set forth in 37 CFR 1.17(c), and sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II. 37 CFR 1.192(b)

This filing is timely. Accordingly, this subsection is not relevant.

III. 37 CFR 1.192(c)

A. 37 CFR 1.192(c)(1) Real Party in Interest

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Florida corporation.

B. 37 CFR 1.192(c)(2) Related Appeals and Interferences

There are no related pending appeals, pending interferences, or requests for interferences known to the Appellants' representative or the Appellants' assignee.

C. 37 CFR 1.192(c)(3) Status of Claims

Claims 1-32 are pending.

Claims 1-32 are appealed.

D. 37 CFR 1.192(c)(4) Status of Amendments

No amendment after the final rejection has been filed.

E. 37 CFR 1.192(c)(5) Summary of the Invention

The present invention provides systems, process, and computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks. For example, one system of the present invention includes an incentive processor for storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks (e.g., see Specification, page 5, lines 6-10; and Figure 2, element 16), at least one incentive printer (e.g., see Specification, page 5, lines 13-15; and Figure 2, element 18), an incentive processor bus coupling the incentive processor to the at least one incentive printer (e.g., see Specification, page 5, lines 19-21; and Figure 2, element 20), a point-of-sale (POS) controller (e.g., see Specification, page 4, line 22 to page 5, line 1; and Figure 2, element 10), at least one cash register (e.g., see Specification, page 5, lines 9-10; and Figure 2, element 14), and a POS bus coupling the POS controller, the at least one cash register, and the incentive processor (e.g., see Specification, page 5, lines 8-10; and Figure 2, element 12). A respective cash register of the at least one cash register is configured to receive data defining an item identifier for an item that is subject to a raincheck (e.g., see Specification, page 5, line 23 to page 6, line 12). One of the POS controller and the respective cash register is configured to transmit the data defining the item identifier for the item that is subject to the raincheck over the POS bus to the incentive processor. (e.g., see Specification, page 5, lines 2-6). The incentive processor is configured to generate raincheck information including at least one purchasing incentive in response to receipt of the data defining the item identifier for the item subject to the raincheck, the plurality purchasing incentives, and the plurality of item identifiers (e.g., see Specification, page 7, lines 3-8). The incentive processor is configured to transmit the raincheck information to a respective

incentive printer of the at least one incentive printer over the incentive processor bus, and the respective incentive printer is configured to print a raincheck including the at least one purchasing incentive in response to receipt of the raincheck information received from the incentive processor (e.g., see Specification, page 7, lines 9-17). (Claims 1, 9, and 17)

One system of the present invention may provide both a retailer site configured to identify the plurality of purchasing incentives corresponding to the plurality of item identifiers and an incentive processing site, wherein the retailer site is configured to transmit the plurality of purchasing incentives corresponding to the plurality of item identifiers to the incentive processing site; the incentive processing site is configured to receive the plurality of purchasing incentives corresponding to the plurality of item identifiers from the retailer site; and the incentive processing site is configured to store the plurality of purchasing incentives corresponding to the plurality of item identifiers via the incentive processor (Claim 2).

One system of the present invention may provide that one of the retailer site and the incentive processing site is configured to generate a raincheck list including a description of items corresponding to the plurality of item identifiers along with the plurality of item identifiers; and the respective cash register of the at least one cash register is configured to receive the data defining the item identifier for an item that is subject to a raincheck based on the raincheck list (Claim 3).

One system of the present invention may provide that the incentive processor is configured to store a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto, and the incentive processing site is configured to generate a weekly report of printed rainchecks and item identifiers corresponding thereto based on the printed raincheck list (Claim 4).

One system of the present invention may provide that the at least one purchasing incentive comprises one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck, and the discount coupon enables a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price (Claim 5).

One system of the present invention may provide that the at least one purchasing incentive comprises at least one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck, and the discount coupon enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price discounted from the price when the item was subject to the raincheck (Claim 6).

One system of the present invention may provide that the item is subject to the raincheck when the item is not in stock (Claim 7).

One system of the present invention may provide that the item is subject to the raincheck when the item is not in stock (Claim 8).

The method, computer program product, and one system of the present invention may provide steps of and means for identifying at a retailer site the plurality of purchasing incentives corresponding to the plurality of item identifiers, transmitting from the retailer site the plurality of purchasing incentives corresponding to the plurality of item identifiers to an incentive processing site, receiving at the incentive processing site the plurality of purchasing incentives corresponding to the plurality of item identifiers from the retailer site, and storing

at the incentive processing site the plurality of purchasing incentives corresponding to the plurality of item identifiers via the incentive processor (Claims 10, 18, and 26).

The method, computer program product, and one system of the present invention may provide steps of and means for generating at one of the retailer site and the incentive processing site a raincheck list including a description of items corresponding to the plurality of item identifiers along with the plurality of item identifiers, and receiving at the respective cash register of the at least one cash register the data defining the item identifier for an item that is subject to a raincheck based on the raincheck list (Claims 11, 19, and 27).

The method, computer program product, and one system of the present invention may provide steps of and means for storing a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto via the incentive processor, and generating at the incentive processing site a weekly report of printed rainchecks and item identifiers corresponding thereto based on the printed raincheck list. (Claims 12, 18, and 26).

The method, computer program product, and one system of the present invention may provide that the at least one purchasing incentive comprises one of a token and a discount coupon and may provide steps of and means for enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck via the token, and enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price via the discount coupon (Claims 13, 18, and 26).

The method, computer program product, and one system of the present invention may provide that the at least one purchasing incentive comprises at least one of a token and a

discount coupon, and further may provide the steps of and means for enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck via the token; and enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price via the discount coupon (Claims 14, 18, and 26).

The method, computer program product, and one system of the present invention may provide steps of and means for subjecting the item to the raincheck when the item is not in stock (Claims 15, 18, and 26).

The method, computer program product, and one system of the present invention may provide steps of and means for subjecting the item to the raincheck when the item is not in stock (Claims 16, 18, and 26).

F. 37 CFR 1.192(c)(6) Issues

Whether the rejection of each one of claims 1-32 under 35 USC §103(a) based upon Off et al (U.S. Pat. No. 5,612,868) in view of Fajkowski (U.S. Pat. No. 5,905,246) should be reversed.

G. 37 CFR 1.192(c)(7) Grouping of Claims

There are the following groups of Claims:

Group 1: Claims 1, 9, 17, and 25; Group 2: Claims 2, 10, 18, and 26; Group 3: Claims 3, 11, 19, and 27; Group 4: Claims 4, 12, 20, and 28; Group 5: Claims 5, 13, 21, and 29; Group 6: Claims 6, 14, 22, and 30; Group 7: Claims 7, 15, 23, and 31; Group 8: Claims 8, 16, 24, and 32.

H. **37 CFR 1.192(c)(8) Argument**

1. **37 CFR 1.192(c)(8)(i)**

There are no rejections under the first paragraph of 35 USC §112. Therefore, this subsection is inapplicable.

2. **37 CFR 1.192(c)(8)(ii)**

There are no rejections under the second paragraph of 35 USC §112. Accordingly, this subsection is inapplicable.

3. **37 CFR 1.192(c)(8)(iii)**

There are no rejections under 35 USC §102. Accordingly, this subsection is inapplicable.

4. **37 CFR 1.192(c)(8)(iv) -Whether the Rejections of Each One of
Claims 1-32 Under 35 USC §103 Based Upon Off et al (U.S. Pat.
No. 5,612,868) in View of Fajkowski (U.S. Pat. No. 5,905,246)
Should be Reversed**

Claims 1-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Off et al (U.S. Pat. No. 5,612,868) in view of Fajkowski (U.S. Pat. No. 5,905,246).

To establish prima facie obviousness of a claimed invention all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The teaching or suggestion to make the modification or combination of prior art and the reasonableness of success must both be found in the prior art. *In re Vaeck*, 947

F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, the proposed modification can not render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900,221. USPQ 1125 (Fed. Cir. 1984).

Off et al discloses a system for generating, in a retail store, a printable discount coupon image solely in response to a customer's action concerning the purchase of an item (Off et al, Abstract). The system of Off et al includes:

...means for automatically generating at least one printable discount coupon image for a product other than a triggering product, based on details of the coupon deal and ***without intervention or participation of the customer*** other than his or her action concerning the purchase of the triggering product (Off et al, col. 2, lines 27-33).

The Official Action acknowledges that Off et al fail to teach the following six features. Off et al fail to teach “an incentive processor for storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks” (Official Action, page 2, lines 22-23), fail to teach “a incentive processor bus coupling said incentive processor to said at least one incentive printer ” (Official Action, page 23, lines 21-22), fail to teach “a POS bus coupling said POS controller, said at least one cash register, and said incentive processor” (Official Action, page 5, lines 11-12), fail to teach that “ a respective cash register of said at least one cash register is configured to receive data defining an item identifier for an item that is subject to a raincheck” (Official Action, page 6, lines 5-7), fail to teach “one of said POS controller and said respective cash register is configured to transmit said data defining said item identifier for said item that is subject to said raincheck over said POS bus to said incentive processor” (Official Action, page 7, lines 3-5), and fail to teach “said incentive processor is configured to generate raincheck information including at least one purchasing incentive in response to receipt of said data defining said item

identifier for said item subject to said raincheck, said plurality purchasing incentives, and said plurality of item identifiers” (Official Action, page 8, lines 6-9).

Fajkowski discloses a system for electronic management and redemption of coupons.

Specifically, Fajkwoski discloses that:

The present invention comprises a system for electronically collecting, carrying and redeeming coupons which eliminates the many disadvantages consumers, retailers and manufacturers face when shepherding paper coupons through the redemption process. One component of the system is a portable coupon card which will include, among other feathers discussed more specifically in the detailed description, a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. The bar code scanner ***allows users to scan*** into the memory means the bar codes on coupons wherever a user may find the coupons. The display screen also allows ***the user to view*** information concerning each coupon such as what product is represented by the coupon and the discount provided by the coupon. Fajkowski, col. 3, lines 50-65.

Fajkowski further discloses that

The present invention also contemplates the "rainchecking" of coupons. Rainchecking a coupon occurs when an item covered by a coupon is out of stock and the coupon will expire before the store can restock the item. Rainchecking allows a customer to utilize the coupon after its expiration date. When a customer has on his coupon card a coupon for an item which is out of stock and the coupon is about to expire, the store may place a marker on the coupon indicating it has been made available for rainchecking. The present invention can raincheck coupons stored in coupon card 1 by entering into coupon card 1 a special raincheck bar code which is recognizable by periphery device 100 and will be provided to the store....At a later date, when the customer seeks to redeem the coupon and his coupon card is read by periphery device 100, the customer may inform the cashier that ***he has rainchecked the coupon.*** Fajkowski, col. 20, lines 34-60.

The Official action asserts that it would be obvious for one of ordinary skill in the art to modify the features of Off et al with selected features of Fajkowski to arrive at the claimed invention. Specifically, the Official Action states that “adding the incentive processor of Fajkowski to Off et al would be advantageous and adding the capability of Fajkowski of

generating rainchecks to Off et al would be a good business strategy. The clients would not have to worry if the item is out of stock and the coupon is soon to expire” (Official Action, page 8, line 21 to page 9, line 3).

Yet, this suggestion to add the raincheck feature of the coupon management and redemption apparatus and method of Fajkowski to the method and apparatus of dispensing discount coupons of Off et al is not found in the prior art itself. Thus, with no suggestion for the modification contained in the prior art itself, the combination of Off et al with Fajkowski is improper.

Further, Applicant asserts that combining the noted features of Fajkowski with Off et al is improper in that the proposed modification of Off et al renders Off et al unsatisfactory for its intended purpose, and thus the proposed modification is improper. The purpose of Off et al is to provide a system for generating a printable discount coupon image *solely in response* to a customer’s action concerning the purchase of an item. Off et al teach that the means for generating the coupon in Off et al act *without any intervention of the customer* (Off et al, col. 2, lines 27-33). Indeed, Off et al do not disclose a customer card or other means for customer identification that would facilitate intervention by the customer. To combine with Off et al the incentive processor of Fajkowski would now require the intervention by the customer, in participating in the coupon selection and raincheck generation process, rendering Off et al unsatisfactory for its intended purpose.

Thus, for the above-stated reasons, the combination of Off et al with Fajkowski is improper, and the 35 U.S.C. § 103 rejection should be withdrawn.

a. **Group 1 - Claims 1, 9, 17, and 25**

The inventions defined by the Group 1 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks. For example, Claim 1 recites:

A system for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks, comprising:

an incentive processor for storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks;

at least one incentive printer;

a incentive processor bus coupling said incentive processor to said at least one incentive printer;

a point-of-sale (POS) controller;

at least one cash register; and

a POS bus coupling said POS controller, said at least one cash register, and said incentive processor;

wherein a respective cash register of said at least one cash register is configured to receive data defining an item identifier for an item that is subject to a raincheck;

one of said POS controller and said respective cash register is configured to transmit said data defining said item identifier for said item that is subject to said raincheck over said POS bus to said incentive processor;

said incentive processor is configured to generate raincheck information including at least one purchasing incentive in response to receipt of said data defining said item identifier for said item subject to said raincheck, said plurality purchasing incentives, and said plurality of item identifiers;

said incentive processor is configured to transmit said raincheck information to a respective incentive printer of said at least one incentive printer over said incentive processor bus; and

said respective incentive printer is configured to print a raincheck including said at least one purchasing incentive in response to receipt of said raincheck information received from said incentive processor.

As admitted, the Off et al reference does not disclose or suggest that the above-referenced six features defined in Claim 1. Moreover, adding the proposed incentive processor (i.e.

server 200) of Fajkowski to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 1 claims.

b. Group 2 - Claims 2, 10, 18, and 26

The inventions defined by the Group 2 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

For example, Claim 2 recites:

The system of Claim 1, further comprising:
a retailer site configured to identify said plurality of purchasing incentives corresponding to said plurality of item identifiers; and
an incentive processing site;
wherein said retailer site configured to transmit said plurality of purchasing incentives corresponding to said plurality of item identifiers to said incentive processing site;
said incentive processing site is configured to receive said plurality of purchasing incentives corresponding to said plurality of item identifiers from said retailer site; and
said incentive processing site is configured to store said plurality of purchasing incentives corresponding to said plurality of item identifiers via said incentive processor.

The Official Action acknowledges that Off et al reference does not teach a retailer site configured to identify the plurality of purchasing incentives corresponding to the plurality of item identifiers, as defined in Claim 2. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which contains a clearinghouse 300 to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require

user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 2 claims.

c. Group 3 - Claims 3, 11, 19, and 27

The inventions defined by the Group 3 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

For example, Claim 3 recites:

The system of Claim 2, wherein one of said retailer site and said incentive processing site is configured to generate a raincheck list including a description of items corresponding to said plurality of item identifiers along with said plurality of item identifiers; and

said respective cash register of said at least one cash register is configured to receive said data defining said item identifier for an item that is subject to a raincheck based on said raincheck list.

The Official Action acknowledges that Off et al reference does not teach one of the retailer site and the incentive processing site is configured to generate a raincheck list including a description of items corresponding to the plurality of item identifiers along with the plurality of item identifiers, and the respective cash register of the at least one cash register is configured to receive the data defining the item identifier for an item that is subject to a raincheck based on the raincheck list, as defined in Claim 3. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which contains a clearinghouse 300 to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended

purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 3 claims.

d. Group 4 - Claims 4, 12, 20, and 28

The inventions defined by the Group 4 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

For example, Claim 4 recites:

The system of Claim 2, wherein said incentive processor is configured to store a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto; and said incentive processing site is configured to generate a weekly report of printed rainchecks and item identifiers corresponding thereto based on said printed raincheck list.

The Official Action acknowledges that Off et al reference does not teach that the incentive processor is configured to store a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto, and the incentive processing site is configured to generate a weekly report of printed rainchecks and item identifiers corresponding thereto based on the printed raincheck list, as defined in Claim 4. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 4 claims.

e. **Group 5 - Claims 5, 13, 21, and 29**

The inventions defined by the Group 5 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

For example, Claim 5 recites:

The system of Claim 2, wherein said at least one purchasing incentive comprises one of a token and a discount coupon;
said token enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck; and
said discount coupon enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price.

The Official Action acknowledges that Off et al reference does not teach that the at least one purchasing incentive comprises one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck; and the discount coupon enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price. as defined in Claim 5. Moreover, the Official Action acknowledges that Fajkowski does not teach explicitly that the raincheck would be a discount coupon or a token. Adding the feature that the raincheck would be a discount coupon or a token is not taught or suggested by Off et al or Fajowski. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 5 claims.

f. **Group 6 - Claims 6, 14, 22, and 30**

The inventions defined by the Group 6 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

For example, Claim 6 recites:

The system of Claim 1, wherein said at least one purchasing incentive comprises at least one of a token and a discount coupon;
said token enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck; and
said discount coupon enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price discounted from said price when said item was subject to said raincheck.

The Official Action acknowledges that Off et al reference does not teach that the at least one purchasing incentive comprises one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck; and the discount coupon enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price discounted from the price when the item was subject to the raincheck, as defined in Claim 6. Moreover, the Official Action acknowledges that Fajkowski does not teach explicitly that the raincheck would be a discount coupon or a token. Adding the feature that the raincheck would be a discount coupon or a token is not taught or suggested by Off et al or Fajowski. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 6 claims.

g. Group 7 - Claims 7, 15, 23, and 31

The inventions defined by the Group 7 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

For example, Claim 7 recites:

The system of Claim 5, wherein said item is subject to said raincheck when said item is not in stock.

The Official Action acknowledges that Off et al reference does not teach that the item is subject to the raincheck when the item is not in stock, as defined in Claim 7. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which teaches rainchecks to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 7 claims.

h. Group 8 - Claims 8, 16, 24, and 32

The inventions defined by the Group 6 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

For example, Claim 8 recites:

The system of Claim 6, wherein said item is subject to said raincheck when said item is not in stock.

The Official Action acknowledges that Off et al reference does not teach that the item is subject to the raincheck when the item is not in stock, as defined in Claim 8. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which teaches rainchecks to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 7 claims. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 8 claims.

5. 37 CFR 1.192(c)(8)(v)

There are no rejections other than those referred to in paragraphs (c)(8)(c)(iv) of subsection 37 CFR 1.192. Accordingly, this subsection is inapplicable.

I. 37 CFR 1.192(c)(9) Appendix

Appendix I contains a clean copy of claims 1-32.

IV. 37 CFR 1.192(d)

This brief is in compliance with 37 CFR 1.192(c). Accordingly, this subsection is inapplicable.

V. **Additional Appendices**

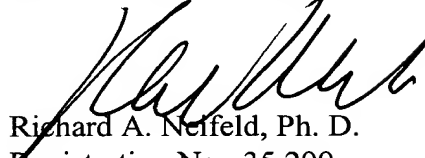
Appendix II - relevant proposed findings of fact.

Appendix III - relevant proposed conclusions of law.

Date

12/3/01

Respectfully submitted,



Richard A. Neifeld, Ph. D.

Registration No. 35,299

Attorney of Record

Ronald A. Rudder, Ph. D.

Registration No. 45,618

OBLON, SPIVAK, McCLELLAND,

MAIER & NEUSTADT, P.C.

Fourth Floor

1755 Jefferson Davis Highway

Arlington, Virginia 22202

(703) 412-6492 (direct dial)

(703) 413-2220 (facsimile)

RNEIFELD@OBLON.COM (e-mail)

Printed: October 3, 2001

I:\atty\RAR\Appeal\7791-0068\brief.wpd

Appendix I

Claims 1-32 in clean form are listed below:

1. A system for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks, comprising:

an incentive processor for storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks;

at least one incentive printer;

a incentive processor bus coupling said incentive processor to said at least one incentive printer;

a point-of-sale (POS) controller;

at least one cash register; and

a POS bus coupling said POS controller, said at least one cash register, and said incentive processor;

wherein a respective cash register of said at least one cash register is configured to receive data defining an item identifier for an item that is subject to a raincheck;

one of said POS controller and said respective cash register is configured to transmit said data defining said item identifier for said item that is subject to said raincheck over said POS bus to said incentive processor;

said incentive processor is configured to generate raincheck information including at least one purchasing incentive in response to receipt of said data defining said item identifier for said item subject to said raincheck, said plurality purchasing incentives, and said plurality of item identifiers;

said incentive processor is configured to transmit said raincheck information to a respective incentive printer of said at least one incentive printer over said incentive processor bus; and

said respective incentive printer is configured to print a raincheck including said at least one purchasing incentive in response to receipt of said raincheck information received from said incentive processor.

2. The system of Claim 1, further comprising:

a retailer site configured to identify said plurality of purchasing incentives corresponding to said plurality of item identifiers; and

an incentive processing site;

wherein said retailer site configured to transmit said plurality of purchasing incentives corresponding to said plurality of item identifiers to said incentive processing site;

said incentive processing site is configured to receive said plurality of purchasing incentives corresponding to said plurality of item identifiers from said retailer site; and

said incentive processing site is configured to store said plurality of purchasing incentives corresponding to said plurality of item identifiers via said incentive processor.

3. The system of Claim 2, wherein one of said retailer site and said incentive processing site is configured to generate a raincheck list including a description of items corresponding to said plurality of item identifiers along with said plurality of item identifiers; and

said respective cash register of said at least one cash register is configured to receive said data defining said item identifier for an item that is subject to a raincheck based on said raincheck list.

4. The system of Claim 2, wherein said incentive processor is configured to store a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto; and

said incentive processing site is configured to generate a weekly report of printed rainchecks and item identifiers corresponding thereto based on said printed raincheck list.

5. The system of Claim 1, wherein said at least one purchasing incentive comprises one of a token and a discount coupon;

said token enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck; and

said discount coupon enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price.

6. The system of Claim 1, wherein said at least one purchasing incentive comprises at least one of a token and a discount coupon;

said token enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck; and

said discount coupon enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price discounted from said price when said item was subject to said raincheck.

7. The system of Claim 5, wherein said item is subject to said raincheck when said item is not in stock.

8. The system of Claim 6, wherein said item is subject to said raincheck when said item is not in stock.

9. A process for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks, comprising:

storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks via an incentive processor;

coupling said incentive processor to at least one incentive printer via an incentive processor bus;

coupling a point-of-sale (POS) controller, at least one cash register, and said incentive processor via a POS bus;

receiving at a respective cash register of said at least one cash register data defining an item identifier for an item that is subject to a raincheck;

transmitting from one of said POS controller and said respective cash register said data defining said item identifier for said item that is subject to said raincheck over said POS bus to said incentive processor;

generating at said incentive processor raincheck information including at least one purchasing incentive in response to receipt of said data defining said item identifier for said item subject to said raincheck, said plurality purchasing incentives, and said plurality of item identifiers;

transmitting from said incentive processor said raincheck information to a respective incentive printer of said at least one incentive printer over said incentive processor bus; and

printing at said respective incentive printer a raincheck including said at least one purchasing incentive in response to receipt of said raincheck information received from said incentive processor.

10. The process of Claim 9, further comprising:

identifying at a retailer site said plurality of purchasing incentives corresponding to said plurality of item identifiers;

transmitting from said retailer site said plurality of purchasing incentives corresponding to said plurality of item identifiers to an incentive processing site;

receiving at said incentive processing site said plurality of purchasing incentives corresponding to said plurality of item identifiers from said retailer site; and

storing at said incentive processing site said plurality of purchasing incentives corresponding to said plurality of item identifiers via said incentive processor.

11. The process of Claim 10, further comprising:

generating at one of said retailer site and said incentive processing site a raincheck list including a description of items corresponding to said plurality of item identifiers along with said plurality of item identifiers; and

receiving at said respective cash register of said at least one cash register said data defining said item identifier for an item that is subject to a raincheck based on said raincheck list.

12. The process of Claim 10, further comprising:

storing a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto via said incentive processor; and

generating at said incentive processing site a weekly report of printed rainchecks and item identifiers corresponding thereto based on said printed raincheck list.

13. The process of Claim 9, wherein said at least one purchasing incentive comprises one of a token and a discount coupon;

the process further comprising one of:

enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck via said token; and

enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price via said discount coupon.

14. The process of Claim 9, wherein said at least one purchasing incentive comprises at least one of a token and a discount coupon;

the process further comprising one of:

enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck via said token; and
enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price via said discount coupon.

15. The process of Claim 13, further comprising subjecting said item to said raincheck when said item is not in stock.

16. The process of Claim 14, further comprising subjecting said item to said raincheck when said item is not in stock.

17. A computer program product comprising a computer storage medium having a computer program embedded in said computer storage medium for causing a computer to provide in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks, said computer program performing the steps of:

storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks via an incentive processor;

coupling said incentive processor to at least one incentive printer via an incentive processor bus;

coupling a point-of-sale (POS) controller, at least one cash register, and said incentive processor via a POS bus;

receiving at a respective cash register of said at least one cash register data defining an item identifier for an item that is subject to a raincheck;

transmitting from one of said POS controller and said respective cash register said data defining said item identifier for said item that is subject to said raincheck over said POS bus to said incentive processor;

generating at said incentive processor raincheck information including at least one purchasing incentive in response to receipt of said data defining said item identifier for said item subject to said raincheck, said plurality purchasing incentives, and said plurality of item identifiers;

transmitting from said incentive processor said raincheck information to a respective incentive printer of said at least one incentive printer over said incentive processor bus; and

printing at said respective incentive printer a raincheck including said at least one purchasing incentive in response to receipt of said raincheck information received from said incentive processor.

18. The computer program of Claim 17, further performing the steps of:
identifying at a retailer site said plurality of purchasing incentives corresponding to said plurality of item identifiers;

transmitting from said retailer site said plurality of purchasing incentives corresponding to said plurality of item identifiers to an incentive processing site;

receiving at said incentive processing site said plurality of purchasing incentives corresponding to said plurality of item identifiers from said retailer site; and

storing at said incentive processing site said plurality of purchasing incentives corresponding to said plurality of item identifiers via said incentive processor.

19. The computer program of Claim 18, further performing the steps of:
generating at one of said retailer site and said incentive processing site a raincheck list including a description of items corresponding to said plurality of item identifiers along with said plurality of item identifiers; and

receiving at said respective cash register of said at least one cash register said data defining said item identifier for an item that is subject to a raincheck based on said raincheck list.

20. The computer program of Claim 18, further performing the steps of:
storing a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto via said incentive processor; and

generating at said incentive processing site a weekly report of printed rainchecks and item identifiers corresponding thereto based on said printed raincheck list.

21. The computer program of Claim 17, wherein said at least one purchasing incentive comprises one of a token and a discount coupon;

the computer program, further performing one of the steps of:
enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck via said token; and

enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price via said discount coupon.

22. The computer program of Claim 17, wherein said at least one purchasing incentive comprises at least one of a token and a discount coupon;

the computer program, further performing one of the steps of:

enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck via said token; and

enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price via said discount coupon.

23. The computer program of Claim 21, performing the step of subjecting said item to said raincheck when said item is not in stock.

24. The computer program of Claim 22, performing the step of subjecting said item to said raincheck when said item is not in stock.

25. A system for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks, comprising:

means for storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks;

means for coupling an incentive processing means to at least one incentive printing means;

means for coupling a point-of-sale (POS) controller means, at least one cash register means, and said incentive processing means;

means for receiving at a respective cash register means of said at least one cash register means data defining an item identifier for an item that is subject to a raincheck;

means for transmitting from one of said POS controller means and said respective cash register means said data defining said item identifier for said item that is subject to said raincheck to said incentive processing means;

means for generating raincheck information including at least one purchasing incentive in response to receipt of said data defining said item identifier for said item subject to said raincheck, said plurality purchasing incentives, and said plurality of item identifiers;

means for transmitting said raincheck information to a respective incentive printing means of said at least one incentive printing means; and

means for printing at said respective incentive printing means a raincheck including said at least one purchasing incentive in response to receipt of said raincheck information.

26. The system of Claim 25, further comprising:

means for identifying at a retailer site said plurality of purchasing incentives corresponding to said plurality of item identifiers;

means for transmitting from said retailer site said plurality of purchasing incentives corresponding to said plurality of item identifiers to an incentive processing site;

means for receiving at said incentive processing site said plurality of purchasing incentives corresponding to said plurality of item identifiers from said retailer site; and

means for storing at said incentive processing site said plurality of purchasing incentives corresponding to said plurality of item identifiers.

27. The system of Claim 26, further comprising:

means for generating at one of said retailer site and said incentive processing site a raincheck list including a description of items corresponding to said plurality of item identifiers along with said plurality of item identifiers; and

means for receiving at said respective cash register means of said at least one cash register means said data defining said item identifier for an item that is subject to a raincheck based on said raincheck list.

28. The system of Claim 26, further comprising:

means for storing a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto; and

means for generating at said incentive processing site a weekly report of printed rainchecks and item identifiers corresponding thereto based on said printed raincheck list.

29. The system of Claim 25, wherein said at least one purchasing incentive comprises one of a token and a discount coupon;

the system further comprising one of:

means for enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck via said token; and

means for enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price via said discount coupon.

30. The system of Claim 25, wherein said at least one purchasing incentive comprises at least one of a token and a discount coupon;

the system further comprising one of:

means for enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a price when said item was subject to said raincheck via said token; and

means for enabling a customer to purchase said item subject to said raincheck when said item is in stock and at a discounted price via said discount coupon.

31. The system of Claim 29, further comprising means for subjecting said item to said raincheck when said item is not in stock.

32. The system of Claim 30, further comprising means for subjecting said item to said raincheck when said item is not in stock.

APPENDIX II. PROPOSED FINDINGS OF FACT

I. Material Facts Regarding the Claimed Invention

1. Claims 1-32 are pending.
2. Claims 1-32 are appealed.
3. No amendment after the final rejection has been filed.
4. The present invention provides systems, process, and computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks. For example, one system of the present invention includes an incentive processor for storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks (e.g., see Specification, page 5, lines 6-10; and Figure 2, element 16), at least one incentive printer (e.g., see Specification, page 5, lines 13-15; and Figure 2, element 18), an incentive processor bus coupling the incentive processor to the at least one incentive printer (e.g., see Specification, page 5, lines 19-21; and Figure 2, element 20), a point-of-sale (POS) controller (e.g., see Specification, page 4, line 22 to page 5, line 1; and Figure 2, element 10), at least one cash register (e.g., see Specification, page 5, lines 9-10; and Figure 2, element 14), and a POS bus coupling the POS controller, the at least one cash register, and the incentive processor (e.g., see Specification, page 5, lines 8-10; and Figure 2, element 12). A respective cash register of the at least one cash register is configured to receive data defining an item identifier for an item that is subject to a raincheck (e.g., see Specification, page 5, line 23 to page 6, line 12). One of the POS controller and the respective cash register is configured to transmit the data defining the item identifier for the item that is subject to the raincheck over the POS bus to the incentive processor. (e.g., see Specification, page 5, lines 2-6). The incentive processor is configured to generate raincheck

information including at least one purchasing incentive in response to receipt of the data defining the item identifier for the item subject to the raincheck, the plurality purchasing incentives, and the plurality of item identifiers (e.g., see Specification, page 7, lines 3-8). The incentive processor is configured to transmit the raincheck information to a respective incentive printer of the at least one incentive printer over the incentive processor bus, and the respective incentive printer is configured to print a raincheck including the at least one purchasing incentive in response to receipt of the raincheck information received from the incentive processor (e.g., see Specification, page 7, lines 9-17). (Claims 1, 9, and 17)

5. One system of the present invention may provide both a retailer site configured to identify the plurality of purchasing incentives corresponding to the plurality of item identifiers and an incentive processing site, wherein the retailer site is configured to transmit the plurality of purchasing incentives corresponding to the plurality of item identifiers to the incentive processing site; the incentive processing site is configured to receive the plurality of purchasing incentives corresponding to the plurality of item identifiers from the retailer site; and the incentive processing site is configured to store the plurality of purchasing incentives corresponding to the plurality of item identifiers via the incentive processor (Claim 2).

6. One system of the present invention may provide that one of the retailer site and the incentive processing site is configured to generate a raincheck list including a description of items corresponding to the plurality of item identifiers along with the plurality of item identifiers; and the respective cash register of the at least one cash register is configured to receive the data defining the item identifier for an item that is subject to a raincheck based on the raincheck list (Claim 3).

7. One system of the present invention may provide that the incentive processor is configured to store a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto, and the incentive processing site is configured to generate a weekly report of printed rainchecks and item identifiers corresponding thereto based on the printed raincheck list (Claim 4).
8. One system of the present invention may provide that the at least one purchasing incentive comprises one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck, and the discount coupon enables a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price (Claim 5).
9. One system of the present invention may provide that the at least one purchasing incentive comprises at least one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck, and the discount coupon enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price discounted from the price when the item was subject to the raincheck (Claim 6).
10. One system of the present invention may provide that the item is subject to the raincheck when the item is not in stock (Claim 7).
11. One system of the present invention may provide that the item is subject to the raincheck when the item is not in stock (Claim 8).
12. The method, computer program product, and one system of the present invention may

provide steps of and means for identifying at a retailer site the plurality of purchasing incentives corresponding to the plurality of item identifiers, transmitting from the retailer site the plurality of purchasing incentives corresponding to the plurality of item identifiers to an incentive processing site, receiving at the incentive processing site the plurality of purchasing incentives corresponding to the plurality of item identifiers from the retailer site, and storing at the incentive processing site the plurality of purchasing incentives corresponding to the plurality of item identifiers via the incentive processor (Claims 10, 18, and 26).

13. The method, computer program product, and one system of the present invention may provide steps of and means for generating at one of the retailer site and the incentive processing site a raincheck list including a description of items corresponding to the plurality of item identifiers along with the plurality of item identifiers, and receiving at the respective cash register of the at least one cash register the data defining the item identifier for an item that is subject to a raincheck based on the raincheck list (Claims 11, 19, and 27).

14. The method, computer program product, and one system of the present invention may provide steps of and means for storing a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto via the incentive processor, and generating at the incentive processing site a weekly report of printed rainchecks and item identifiers corresponding thereto based on the printed raincheck list. (Claims 12, 18, and 26).

15. The method, computer program product, and one system of the present invention may provide that the at least one purchasing incentive comprises one of a token and a discount coupon and may provide steps of and means for enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to

the raincheck via the token, and enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price via the discount coupon (Claims 13, 18, and 26).

16. The method, computer program product, and one system of the present invention may provide that the at least one purchasing incentive comprises at least one of a token and a discount coupon, and further may provide the steps of and means for enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck via the token; and enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price via the discount coupon (Claims 14, 18, and 26).

17. The method, computer program product, and one system of the present invention may provide steps of and means for subjecting the item to the raincheck when the item is not in stock (Claims 15, 18, and 26).

18. The method, computer program product, and one system of the present invention may provide steps of and means for subjecting the item to the raincheck when the item is not in stock (Claims 16, 18, and 26). (Claim 1).

II. Material Facts Relevant to Argument

19. Claims 1-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Off et al (U.S. Pat. No. 5,612,868) in view of Fajkowski (U.S. Pat. No. 5,905,246).

20. To establish prima facie obviousness of a claimed invention all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the modification or combination

of prior art and the reasonableness of success must both be found in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

21. Off et al discloses, as illustrated by the Figure immediately attached, a system for generating, in a retail store, a printable discount coupon image solely in response to a customer's action concerning the purchase of an item (Off et al, Abstract). The system of Off et al includes:

...means for automatically generating at least one printable discount coupon image for a product other than a triggering product, based on details of the coupon deal and ***without intervention or participation of the customer*** other than his or her action concerning the purchase of the triggering product (Off et al, col. 2, lines 27-33).

22. The Official Action acknowledges that Off et al fail to teach the following six features. Off et al fail to teach “an incentive processor for storing a plurality of purchasing incentives corresponding to a plurality of item identifiers for items subject to rainchecks” (Official Action, page 2, lines 22-23), fail to teach “a incentive processor bus coupling said incentive processor to said at least one incentive printer ” (Official Action, page 23, lines 21-22), fail to teach “a POS bus coupling said POS controller, said at least one cash register, and said incentive processor” (Official Action, page 5, lines 11-12), fail to teach that “ a respective cash register of said at least one cash register is configured to receive data defining an item identifier for an item that is subject to a raincheck” (Official Action, page 6, lines 5-7), fail to teach “one of said POS controller and said respective cash register is configured to transmit said data defining said item identifier for said item that is subject to said raincheck over said POS bus to said incentive processor” (Official Action, page 7, lines 3-5), and fails to teach “said incentive processor is configured to generate raincheck information including at least one purchasing incentive in response to receipt of said data defining said item

identifier for said item subject to said raincheck, said plurality purchasing incentives, and said plurality of item identifiers” (Official Action, page 8, lines 6-9).

23. Fajkowski discloses a system for electronic management and redemption of coupons.

Specifically, Fajkowski discloses:

The present invention comprises a system for electronically collecting, carrying and redeeming coupons which eliminates the many disadvantages consumers, retailers and manufacturers face when shepherding paper coupons through the redemption process. One component of the system is a portable coupon card which will include, among other features discussed more specifically in the detailed description, a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. The bar code scanner *allows users to scan into the memory* means the bar codes on coupons wherever a user may find the coupons. The display screen also allows *the user to view* information concerning each coupon such as what product is represented by the coupon and the discount provided by the coupon. Fajkowski, col. 3, lines 50-65.

Fajkowski further discloses that

The present invention also contemplates the "rainchecking" of coupons. Rainchecking a coupon occurs when an item covered by a coupon is out of stock and the coupon will expire before the store can restock the item. Rainchecking allows a customer to utilize the coupon after its expiration date. When a customer has on his coupon card a coupon for an item which is out of stock and the coupon is about to expire, the store may place a marker on the coupon indicating it has been made available for rainchecking. The present invention can raincheck coupons stored in coupon card 1 by entering into coupon card 1 a special raincheck bar code which is recognizable by periphery device 100 and will be provided to the store....At a later date, when the customer seeks to redeem the coupon and his coupon card is read by periphery device 100, the customer may inform the cashier that *he has rainchecked the coupon*. Fajkowski, col. 20, lines 34-60.

24. The Official action asserts that it would be obvious for one of ordinary skill in the art to modify the features of Off et al with selected features of Fajkowski to arrive at the claimed invention. Specifically, the Official Action states that “adding the incentive processor of Fajkowski to Off et al would be advantageous and adding the capability of Fajkowski of

generating rainchecks to Off et al would be a good business strategy. The clients would not have to worry if the item is out of stock and the coupon is soon to expire” (Official Action, page 8, line 21 to page 9, line 3).

25. Yet, this suggestion to add the raincheck feature of the coupon management and redemption apparatus and method of Fajkowski to the method and apparatus of dispensing discount coupons of Off et al is not found in the prior art itself. Thus, with no suggestion for the modification contained in the prior art itself, the combination of Off et al with Fajkowski is improper.

26. Further, Applicant asserts that combining the noted features of Fajkowski with Off et al is improper in that the proposed modification of Off et al renders Off et al unsatisfactory for its intended purpose, and thus the proposed modification is improper. The purpose of Off et al is to provide a system for generating a printable discount coupon image solely in response to a customer’s action concerning the purchase of an item. Off et al teach that the means for generating the coupon in Off et al act without any intervention of the customer. Indeed, Off et al do not disclose a customer card or other means for customer identification that would facilitate intervention by the customer. To combine with Off et al the incentive processor of Fajkowski would now require the intervention by the customer, in participating in the coupon selection and raincheck generation process, rendering Off et al unsatisfactory for its intended purpose.

27. Thus, for the above-stated reasons, the combination of Off et al with Fajkowski is improper, and the 35 U.S.C. § 103 rejection should be withdrawn.

APPENDIX III

PROPOSED CONCLUSIONS OF LAW

a. Group 1 - Claims 1, 9, 17, and 25

1. The inventions defined by the Group 1 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.
2. As admitted, the Off et al reference does not disclose or suggest that the above referenced six features defined in Claim 1. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 1 claims.

b. Group 2 - Claims 2, 10, 18, and 26

3. The inventions defined by the Group 2 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.
4. The Official Action acknowledges that Off et al reference does not teach a retailer site configured to identify the plurality of purchasing incentives corresponding to the plurality of item identifiers, as defined in Claim 2. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which contains a clearinghouse 300 to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require

user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 2 claims.

c. Group 3 - Claims 3, 11, 19, and 27

5. The inventions defined by the Group 3 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

6. The Official Action acknowledges that Off et al reference does not teach one of the retailer site and the incentive processing site is configured to generate a raincheck list including a description of items corresponding to the plurality of item identifiers along with the plurality of item identifiers, and the respective cash register of the at least one cash register is configured to receive the data defining the item identifier for an item that is subject to a raincheck based on the raincheck list, as defined in Claim 3. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which contains a clearinghouse 300 to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 3 claims.

d. Group 4 - Claims 4, 12, 20, and 28

7. The inventions defined by the Group 4 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

8. The Official Action acknowledges that Off et al reference does not teach that the incentive processor is configured to store a printed raincheck list comprising a list of when rainchecks were printed and item identifiers corresponding thereto, and the incentive processing site is configured to generate a weekly report of printed rainchecks and item identifiers corresponding thereto based on the printed raincheck list, as defined in Claim 4. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 4 claims.

d. Group 5 - Claims 5, 13, 21, and 29

9. The inventions defined by the Group 5 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

10. The Official Action acknowledges that Off et al reference does not teach that the at least one purchasing incentive comprises one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock

and at a price when the item was subject to the raincheck; and the discount coupon enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a discounted price. as defined in Claim 5. Moreover, the Official Action acknowledges that Fajkowski does not teach explicitly that the raincheck would be a discount coupon or a token. Adding the feature that the raincheck would be a discount coupon or a token is not taught or suggested by Off et al or Fajowski. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 5 claims.

e. Group 6 - Claims 6, 14, 22, and 30

11. The inventions defined by the Group 6 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

12. The Official Action acknowledges that Off et al reference does not teach that the at least one purchasing incentive comprises one of a token and a discount coupon, the token enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price when the item was subject to the raincheck; and the discount coupon enabling a customer to purchase the item subject to the raincheck when the item is in stock and at a price discounted from the price when the item was subject to the raincheck, as defined in Claim 6. Moreover, the Official Action acknowledges that Fajkowski does not teach explicitly that the raincheck would be a discount coupon or a token. Adding the feature that the raincheck would be a discount coupon or a token is not taught or suggested by Off et al or

Fajowski. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 6 claims.

e. Group 7 - Claims 7, 15, 23, and 31

13. The inventions defined by the Group 7 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

14. The Official Action acknowledges that Off et al reference does not teach that the item is subject to the raincheck when the item is not in stock, as defined in Claim 7. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which teaches rainchecks to Off et al, as suggested in the Official Action, is not suggested by Off et al or Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 7 claims.

e. Group 8 - Claims 8, 16, 24, and 32

15. The inventions defined by the Group 6 claims provide systems, process, and a computer program product for providing in-store printing of rainchecks for purchasing incentives associated with items subject to rainchecks.

16. The Official Action acknowledges that Off et al reference does not teach that the item is subject to the raincheck when the item is not in stock, as defined in Claim 8. Moreover, adding the proposed incentive processor (i.e. server 200) of Fajkowski which teaches rainchecks to Off et al, as suggested in the Official Action, is not suggested by Off et al or

Fajowski and will require user participation, thus rendering Off et al unsatisfactory for its intended purpose. Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 7 claims.

Therefore, a combination of the disclosure of Off et al and Fajkowski is improper and does not make obvious the inventions defined by the Group 8 claims.

I:\atty\RAR\Appeal\7791-0068\brief.wpd